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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,241	09/09/2004	Kurt Stark	WAS0642PUSA	9080

22045 7590 09/20/2006

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/507,241

Applicant(s)

STARK ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24 to 46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 24 to 34, 38 to 46 is/are rejected.
- 7) ☒ Claim(s) 35 to 37 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. Claims 24 and 35 are objected to because of the following informalities: In the definition of the solvents, please note that $20 \cdot 10^{-4}$ should be 20×10^{-4} . Appropriate correction is required.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 24 to 34 and 38 to 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone et al. or Getson.

For both of these rejections, please note the following: Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the *product* in the product-by-process claim is the same as or *obvious from a product of the prior art*, the claim is unpatentable even though the prior product was made by a different process.

In the instant application, the claimed copolymer is obvious in view of the teachings found in DeSimone et al. and Getson.

4. DeSimone et al. teach a process of polymerizing in a carbon dioxide medium. Please see Examples 11 through 13 in which vinyl acetate is polymerized with a mono-vinyl terminated polydimethylsiloxane in weight amounts that meet that claimed. While the "n" value of the siloxane in these examples is not specifically shown, the molecular weight of these polymers will inherently place them within the claimed "n" range. These examples differ from the instant claims in 2 ways.

First the examples use monovinyl terminated siloxanes rather than di-terminated siloxanes. This difference, however, is rendered obvious by the teachings on column 5, starting on line 40. This teaches various polymerization stabilizers and discloses that

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both divinyl and monovinyl terminated polysiloxanes can be used in the alternative. From this the skilled artisan would have found the use of a polysiloxane meeting the formula b) in claim 24 and having two polymerizable vinyl terminal groups in place of the monovinyl polysiloxane used in these examples to have been obvious.

The second difference is that the copolymer in DeSimone et al. is not prepared in the presence of the specific solvents required. This is a product by process limitation. As noted supra, since the product that is rendered obvious by the teachings in DeSimone et al. appears to be the same as that claimed, the claimed copolymer is unpatentable over DeSimone et al. even though it is prepared by a different method. That is, it does not appear that the presence of a different solvent or reaction medium results in an inherently different final product.

5. Getson teaches modified organopolysiloxanes which are formed by the reaction of a vinyl containing organopolysiloxane and a monomer having aliphatic unsaturation. See particularly the copolymer produced in Example 6 which is the reaction product between vinyl acetate and a dimethylvinyl terminated polysiloxane. These reactants are used in an amount meeting that in claim 24 and the viscosity of the polysiloxane will result in a copolymer that has the necessary "n" value. This copolymer differs from that claimed in two ways.

First note that it contains internal vinyl groups which are excluded from the silicone formula in b). This difference, however, is rendered obvious by the teachings in Getson which show on column 3 that vinyl terminated siloxanes having no internal vinyl groups can be used in the alternative with siloxanes having internal vinyl groups. Note for instance that Example 1 uses such a siloxane, albeit not with a vinyl acetate monomer. Thus one having ordinary skill in the art would have found the use of a silicone meeting the formula found in b) in claim 24, also meeting that required by claims 26 and 27, in place of that used in Example 6 to have been obvious.

The second difference is that the copolymer in Getson is not prepared in the presence of the specific solvents required. Column 5, line 40 and on, teaches various nonaqueous solvents including some that fall within the breadth of claim 31 but does not

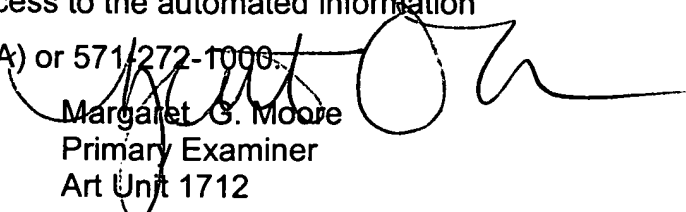
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adequately suggest the specific mixture of solvents required by this claim. However this is a product by process limitation. As noted supra, since the product that is rendered obvious by the teachings in Getson appears to be the same as that claimed the claimed copolymer is unpatentable over Getson even though its prepared by a different method. That is, it does not appear that the presence of a different solvent or reaction medium results in an inherently different final product.

6. Claims 35 to 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. These claims require that the polymerization be carried out in the presence of a specific combination of solvents. Such a combination is not taught nor adequately suggested by the prior art.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571/272-1000.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
9/16/06